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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,162	06/26/2003	Kimihiko Sano	03383/LH	7848
1933	7590	09/16/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/609,162

Applicant(s)

SANO ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,5,6,8,10 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5,6,8,10 and 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 112 rejection of claims 1-27 of record in the Office Action mailed 3/23/05, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendment filed 6/23/05.
2. The 35 U.S.C. 102 rejection of claims 1, 4-20 and 23-27 as anticipated by JP 8-1916 of record in the Office Action mailed 3/23/05, Pages 3-5, Paragraph #4 has been withdrawn due to the Applicant's amendment filed 6/23/05.
3. The 35 U.S.C. 102 rejection of claims 1, 2, 4, 7, 9, 11, 12, 17-23 and 25-27 as anticipated by Hamuro et al. of record in the Office Action mailed 3/23/05, Pages 5-6, Paragraph #5 has been withdrawn due to the Applicant's amendment filed 6/23/05.
4. The 35 U.S.C. 102 rejection of claims 1-4, 7-23 and 25-27 as anticipated by Sakurai of record in the Office Action mailed 3/23/05, Pages 6-8, Paragraph #6 has been withdrawn due to the Applicant's amendment filed 6/23/05.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2, 5, 6, 8, 10 and 13-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Okabe (JP 2-206140; refer to the translation copy).

Okabe discloses a plate-like protective film comprising a plate-like material main body (Fig. 3, element 1) which protects a protected plate-like material structure (Fig. 3, element 3), projections which are arranged continuously in predetermined areas of the plate-like material main body and which are formed by respective parts of the plate-like material main body to extend from a base portion of the plate-like material main body (Fig. 3, element 10a), wherein each of the projections comprise a crown portion having a surface that is a plane that is substantially parallel with a main surface of the protected plate-like material structure (Fig. 3, element 10a), and a side wall portion extending from the crown portion (Fig. 3, element 10). Regarding claim 5, the plurality of projections (Fig. 3, element 10a) project in at least two different directions from the base portion of the plate-like material main body. Regarding claim 6, the plurality of projections comprise first projections (Fig. 3, element 10a) projecting from one surface of the plate-like material main body, and second projections (Fig. 3, element 10a) projecting from another surface of the plate-like material main body, and the first and second projections are arranged alternately along a direction in which the projections are arranged (Fig. 3, element 10a). Regarding claim 8, the plurality of crown portions have different widths (Fig. 3, element 10a). Regarding claim 10, an amount by which the projection provided at one widthwise end of the plate-like protective film is shifted with respect to a corresponding projection at another widthwise end is not smaller than  $\frac{1}{4}$  pitch and is not larger than  $\frac{3}{4}$  pitch (Fig. 3, element 10a). Regarding claim 13, respective gap portions are formed between the plurality of projections (Fig. 3, element 10a), and the respective gap portions have at least two different widths. Regarding claim 14, the projections are substantially trapezoidal as viewed from an end surface side of the plate-like material main body (Fig. 1(b), element 10). Regarding claims 15

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and 16, the projections are substantially u-shaped and semicircular as viewed from one surface side of the plate-like material main body (Fig. 2(b), element 20). Regarding claims 17-19, the protected plate-like material structure (Fig. 3) comprises interconnect patterns and electronic components such as semiconductor chips, and the predetermined areas of the plate-like material main body are not superimposed on the interconnect patterns and electronic components (see page 2, paragraphs 2 and 3). Regarding claim 20, the plate-like material main body (Fig. 3, element 1) is long enough to protect the protected plate-like material structure (Fig. 3, element 3). Regarding claim 21, the protected plate-like material structure comprises sprocket holes (Fig. 1(c), element 3a), and the predetermined areas of the plate-like material main body are in proximity to the sprocket holes (Fig. 1(c), element 10a). Regarding claim 22, the protected plate-like material structure comprises sprocket holes at opposite widthwise ends thereof (Fig. 1(c), element 3a) and the predetermined areas of the plate-like material main body are the opposite widthwise ends of the plate-like material main body (Fig. 1(c), element 10a). Regarding claim 23, the plate-like material main body has a sheet form (Fig. 3, element 1) so as to protect the protected plate-like material structure, which also has a sheet form (Fig. 3, element 3). Regarding claim 24, the predetermined areas of the plate-like material main body are two opposite side areas of the plate-like material main body (Fig. 3, element 10a). Regarding claim 25, the predetermined areas of the plate-like material main body are at least four side areas of the plate-like material main body (Fig. 1(a), element 10).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe (JP 2-206140; refer to the translation copy) in view of Odaka (JP 2002-076064; refer to the translation copy).

Okabe discloses the claimed plate-like protective film as shown above except for conductive layers being provided on respective surfaces of the plate-like material main body. Odaka teaches that it is old and well-known in the art to provide conductive layers on respective surfaces of a plate-like material main body (Drawing 5, elements 28) for the purpose of preventing generation of electrostatic charge to the utmost, peeling of conductive films and generation of conductive foreign particles accompanied by peeling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided conductive layers on respective surfaces of the plate-like material main body in Okabe as suggested by Odaka in order to prevent generation of electrostatic charge to the utmost, peeling of conductive films and generation of conductive foreign particles accompanied by peeling.

***Response to Arguments***

9. Applicant's arguments with respect to claims 2, 5, 6, 8, 10 and 13-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CAS

Catherine A. Simone  
Examiner  
Art Unit 1772  
September 13, 2005

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 9/14/05